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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,949	01/22/2001	Daniel B. Workman	1958.2009-000	3380

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EXAMINER
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BASEHOAR, ADAM L

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 05/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/766,949

Applicant(s)

WORKMAN ET AL.

Examiner

Adam L Basehoar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This action is responsive to communications: The Amendment filed 09/27/04 to the original Application filed on 01/22/01.
2. Claims 15-50 have been added as necessitated by the Amendment.
3. The rejection of claims 1-14 remain under 35 U.S.C. 102(b) as being anticipated by Bergman et al (5,909,678 06/01/99).
4. The rejection of claim 14 remains under 35 U.S.C. 101.
5. Claims 1-50 are pending in the case. Claims 1, 11, 13-14, and 41 are independent claims.

#### *Claim Rejections - 35 USC § 101*

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claim 14 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The currently recited claim discloses of a computer data signal representing program code embodied in a carrier wave, which is non-statutory. The examiner notes that the claim is rejected under 35 U.S.C. 101 because the computer data signal representing program code on a carrier wave is not tangible. The claim must be amended to have the computer data signal be embodied on a tangible medium such as a computer readable medium. Please reference MPEP section 2106 below:

a) Functional Descriptive Material: "Data Structures" Representing Descriptive Material Per Se or Computer Programs Representing Computer Listings Per Se  
**Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory** because they are not capable of causing functional

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change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

Similarly, computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. Accordingly, it is important to distinguish claims that define descriptive material per se from claims that define statutory inventions.

Computer programs are often recited as part of a claim. Office personnel should determine whether the computer program is being claimed as part of an otherwise statutory manufacture or machine. In such a case, the claim remains statutory irrespective of the fact that a computer program is included in the claim. The same result occurs when a computer program is used in a computerized process where the computer executes the instructions set forth in the computer program. Only when the claimed invention taken as a whole is directed to a mere program listing, i.e., to only its description or expression, is it descriptive material per se and hence nonstatutory.

Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and Office personnel should treat a claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, as nonstatutory functional descriptive material. When a computer program is claimed in a process where the computer is executing the computer program's instructions, Office personnel should treat the claim as a process claim. See paragraph IV.B.2(b), below. When a computer program is recited in conjunction with a physical structure, such as a computer memory, Office personnel should treat the claim as a product claim.

### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-50 are rejected under 35 U.S.C. 102(b) as being anticipated by Bergman et al (5,909,678 06/01/99).

-In regard to independent claims 1, 11, 13-14, and 41 Bergman et al teach a method, system, and product for editing a form, wherein;

a user was displayed an interface (Fig. 9: 911) displaying a hyperlink (phrase receptacle) for an element in the form (column 3, lines 17-18) (Fig. 4: 200) indicating to a user that a control is available for the element (column 3, lines 46-49); wherein

upon selection of the hyperlink of the element, the control displayed on the user interface for user interaction (Fig. 3: Selection of element 200 displays control 11 for user interaction); and wherein

upon completion of user interaction with the control, replacing the element with a new element responsive to user (Fig. 2: Select element 210 and Fig 3: Replace element with new element 210 selected from control 11) .

-In regard to dependent claims 2-3, 15-16, 23-24, 32-33, and 42-43, Bergman et al teach wherein the form was a database query (column 5, lines 27-36) or spreadsheet (equivalent to a database) (column 5, lines 22-26).

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-In regard to dependent claims 4-5, 17-18, 25-26, 34-35, and 44-45, Bergman et al teach wherein the element was part of a formula or calculation (column 3, lines 9-10)(column 14, lines 25-30).

-In regard to dependent claims 6-7, 19-20, 27-28, 36-37, and 46-47, Bergman et al teach wherein the control was a list of choices or a pull-down menu (column 8, lines 5-8)(Fig. 3&4).

-In regard to dependent claims 8-9, 21-22, 29-30, 38-39, and 48-49, Bergman et al wherein the control was a dialog box or text entry field (column 8, lines 6-8).

-In regard to dependent claims 10, 12, 31, 40, and 50, Bergman et al Bergman et al further teach wherein the control was selected from a group of controls consisting of a list (Fig. 3), a dialog box, and a text entry field (column 8, lines 5-8).

### ***Response to Arguments***

10. Applicant's arguments filed 09/27/04 have been fully considered but they are not persuasive.

-In regard to independent claim 1, the Applicant argues that Bergman does not teach or suggest "displaying a hyperlink for an element in the form, to indicate to a user that a control is available for the element." The examiner respectfully disagrees with the applicant and believes Bergman does teach said features. Bergman teaches displaying a phrase receptacle (i.e. hyperlink) within a form query phrase template (Fig. 2: 201). The

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phrase receptacle is a placeholder for user action, wherein the receptacle indicates to the user that control was available for that element (column 3, lines 6-18). The receptacle indicates this to the user via double brackets “[ ]” (column 3, lines 15-18) or by other common methods in the art such as using color or shape (columns 6 & 7, lines 62-64 & 4-9). The user may use the control via the common drag and drop feature (column 7, lines 10-15) or the user may select a receptacle by clicking on the receptacle (column 7, lines 38-42) and activating the common controls which include type-in fields, menus, toggle buttons, pull down (choice) menus, add/delete buttons, etc, in order to guide a user to the available choices for the element (columns 3 & 4, lines 67 & 1-2; column 8, lines 6-8). In this way Bergman is believed to teach the limitations of the independent claims. For the purposes of examination, the scope of the term “hyperlink” has been viewed broadly as a selectable region for a given element that implies user input.

-In regard to the rejection of independent claim 14, under 35 U.S.C 101, the examiner respectfully disagrees with the applicant and has maintained the rejection based on the claim not being tangibly embodied. See noted MPEP sections listed above.

### ***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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11-2004

Hartel et al.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam L Basehoar whose telephone number is (571)-272-4121. The examiner can normally be reached on M-F: 7:00am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ALB



**STEPHEN HONG**  
**SUPERVISORY PATENT EXAMINER**